

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on September 25, 2003, and the references cited therewith.

Claims 4, 8, 15, 17, 19, 24 and 27 are amended, claims 10, 23 and 30 are canceled, and claims 31-47 are added; as a result, claims 1-10 and 12-47 are now pending in this application. Claims 8, 19 and 27 have been amended to incorporate elements from claims that were objected to, but indicated to be allowable if rewritten, and are not in response to any art-based rejections. The amendments to claims 4, 15, 17, and 24 are intended to clarify and more particularly describe elements in the claims as previously presented.

§102 Rejection of the Claims

Claims 1, 3-5, 7-8, 12, 14-15, 17-19, 21-22, 24 and 26-29 were rejected under 35 USC § 102(b) as being anticipated by Goldsmith (US 5,649,024). Applicant respectfully traverses the rejection and requests reconsideration of the claims in light of the remarks below.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Applicant respectfully submits that the Office Action did not make out a *prima facie* case of anticipation because the claims contain elements not found in the cited art.

For example, claims 1 and 12 recite “changing the color designation to a printing color designation wherein the color designation remains unchanged for display” (emphasis added). Applicant has reviewed Goldsmith and can find no teaching of the recited language. While Goldsmith discloses that the document itself may remain unchanged, Goldsmith is silent as to what happens to displayed fonts following selection in Goldsmith. It is not inherent in Goldsmith that the displayed fonts remain unchanged following selection. As a result,

Goldsmith does not teach or disclose that the color designation remains unchanged for display. Therefore Goldsmith does not teach each and every element of Applicant's claim 1 and 12. Applicant respectfully requests the withdrawal of the rejection of claims 1 and 12.

Claim 3 depends from claim 1 and claim 14 depends from claim 12. These dependent claims inherit the elements of claims 1 and 12 respectively, while adding further patentable distinctions. Applicant respectfully submits that claims 3 and 14 are therefore allowable for the reasons discussed above with respect to their base claims 1 and 12.

Claim 4 as amended recites "displaying a plurality of printable information units in a text processing document." Claims 15, 17 and 24 recite similar language. Applicant has reviewed Goldsmith and can find no teaching of the recited language. Goldsmith teaches that scanned images can be described in a PDL (Page Description Language) that provides a high level description of a scanned page. As noted in Goldsmith, the scanned page may undergo an OCR (Optical Character Recognition) process in order to convert recognized characters into text (see column 6, lines 58-67). However, no text processing capability is disclosed in Goldsmith. In contrast, Applicant's claims 4, 15, 17 and 24 recite a text processing document such as that of a word processor or e-mail program. A text processing document is different from a page description language document, and as a result Goldsmith does not teach each and every element of Applicant's claims 4, 15, 17 and 24. Therefore Applicant respectfully requests the withdrawal of the rejection of claims 4, 15, 17 and 24.

Claims 5 and 7 depend from claim 4; claim 18 depends from claim 17 and claim 26 depends from claim 24. These dependent claims inherit each of the elements of their respective base claims and are allowable for the reasons discussed above with respect to the base claims. Applicant respectfully requests the withdrawal of the rejection of claims 5, 7, 18 and 26.

Claims 10, 23 and 30 were indicated to be allowable if rewritten to incorporate their respective base claim elements. Applicant has chosen to incorporate the elements of claims 10, 23 and 30 into their respective base claims 8, 19 and 27. Applicant respectfully submits that claims 8, 19 and 27 are now allowable for the same reasons as claims 10, 23 and 30.

Claims 21-22 depend from claim 19 and claims 28-29 depend from claim 27. These dependent claims inherit all of the elements recited in their respective base claims. Applicant

respectfully submits that claims 21-22 and 28-29 are allowable for the same reason as discussed above with respect to claims 19 and 27.

§103 Rejection of the Claims

Claims 2, 6, 9, 13, 16, 18, 20 and 25 were rejected under 35 USC § 103(a) as being unpatentable over Goldsmith in view of Nickell et al. (US 5,113,356). In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Applicant respectfully traverses the rejection because the cited references fail to teach each and every element of Applicant's claims.

For example, claims 2 and 13 inherit the recitation of "changing the color designation to a printing color designation wherein the color designation remains unchanged for display" from their respective base claims 1 and 12. As noted above, Goldsmith fails to teach or disclose the recited language. Applicant has reviewed Nickell and can find no teaching of the recited language. Nickell, like Goldsmith, is silent as to what happens to graphical objects that have been selected for color changes. Additionally, it is not inherent that the color of the graphical objects in Nickell remain unchanged, the graphical objects could just as well have the colors changed on the display. As a result, the combination of Goldsmith and Nickell fails to teach each and every element of Applicant's claims 2 and 13. Applicant respectfully requests the withdrawal of the rejection of claims 2 and 13.

Claim 6 depends from claim 4, claim 16 depends from claim 15, claim 18 depends from claim 17 and claim 25 depends from claim 24. Each of these dependent claims therefore inherits the recitation of "a plurality of printable information units of a text processing document." As discussed above, Goldsmith teaches a PDL file, not a text processing document. Similarly,

Nickell also teaches the use of a PDL and not a text processing document. Therefore the combination of Goldsmith and Nickell fails to teach each and every element of Applicant's claims 6, 16, 18 and 25. Applicant respectfully requests the withdrawal of the rejection of claims 6, 16, 18 and 25.

Claim 9 depends from claim 8 and claim 20 depends from claim 19. As argued above, Applicant believes claims 8 and 19 to be allowable. Applicant respectfully submits that claims 9 and 20 are allowable as being dependent on an allowable base claim.

Allowable Subject Matter

Applicant notes that claims 10, 23 and 30 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As noted above, Applicant has amended the respective base claims to include the features of claims 10, 23, and 30 and canceled without prejudice or disclaimer claims 10, 23, and 30.

New Claims 31-47

New claims 31-47 have been added in this response. Support for new claims 31-47 can be found throughout the specification, and in particular on pages 7-11 of the specification. Applicant believes that no new matter has been introduced with the introduction of the new claims.

Additionally, Applicant respectfully submits that new claims 31-47 are distinguishable over the cited references. For example, neither Goldsmith nor Nickell teach or disclose changing the color of a subset of printable information units based on a group identification. Further, neither Goldsmith nor Nickell teach or disclose changing the color based on the subset comprising footnote text.

Moreover, neither Goldsmith nor Nickell teach or disclose text that is included in the subset without regard to text characteristics. For example, Goldsmith teaches that text color may be printed in a changed color based on the text being a particular font. Nickell teaches that text color may be printed in a changed color based on the text being a particular font or having a

particular style such as underlining, italic, etc. However, neither Goldsmith nor Nickell teach the selection of a subset without regard to such characteristics.

Finally, neither Goldsmith nor Nickell teach that overriding printing colors for text documents such as HTML documents, word processing documents, or electronic mail messages.

For the above reasons, Applicant submits that new claims 31-47 are allowable.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6954) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.

Respectfully submitted,


FRANK W. LIEBENOW

By his Representatives,

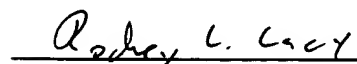
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